



UNITED STATES PATENT AND TRADEMARK OFFICE

4CT
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/370,601 | 08/10/1999 | KRISTINE B. FUIMAONO | 34063/KMO/W1 | 8267 |

23363 7590 09/27/2002
CHRISTIE, PARKER & HALE, LLP
350 WEST COLORADO BOULEVARD
SUITE 500
PASADENA, CA 91105

| |
|----------|
| EXAMINER |
|----------|

RODRIGUEZ, CRIS LOIREN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3763
DATE MAILED: 09/27/2002 20

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-------------------------------|---------------------------------------|
| Office Action Summary | Application No. 09/370,601 | Applicant(s) FUIMAONO, KRISTINE B. |
| | Examiner Cris L. Rodriguez | Art Unit 3763 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 28 June 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 2-53 is/are pending in the application.
- 4a) Of the above claim(s) 24-47, 50 and 53 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 2-23, 48, 49, 51 and 52 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 50, and 53 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 50 and 53 depends from non-elected claims.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 50 and 53 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 15 and 16 are indefinite because it is not clear if the flexible plastic is the same or in addition to the infusion tube set forth in claim 6.

Claim Rejections - 35 USC § 103

4. Claims 2-4, 6-12, 14-23, 48, 49, 51, 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lorentzen (US 5,951,546) in view of Panescu et al (US 6,056,745).

Lorentzen discloses an electro surgical instrument for tissue ablation having a probe body 10 with an ablation electrode made of stainless steel, means for introducing fluid into the inner cavity (pump not shown), and a handle at 20. The probe body is generally rigid from its proximal to its distal end, and defines an inner

cavity where cooling water pass within the cavity (Fig. 2a). However, Lorentzen fails to disclose the ablation electrode having an irrigation opening to pass the fluid from the inner cavity to the outside of the ablation electrode, and the length and the diameters of the electrode and probe body as claimed.

Panescu teaches ablation catheters (fig. 2a and 6) having a catheter body 22, a cooling assembly, and an electrode 16. Panescu teaches that the electrodes can have open or close end as shown. The electrodes, in figure 2a and 6, are cooled during ablation. Given the teachings, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include Panescu's openings into Lorentzen's ablation instrument. Doing so would have cooled the electrode, and further the tissue area to avoid charring. Furthermore, the instant disclosure describes the length and diameters dimensions as being merely preferable, and does not describe it as contributing any unexpected result to the probe. As such, these parameters are deemed matters of design choice (lacking in any criticality), well within the skill of the ordinary artisan, obtained through routine experimentation in determining optimum results

5. Claims 5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lorentzen in view of Panescu et al ('745), and further in view of Ashley (6,176,857).

Lorentzen/Panescu discloses the invention substantially as claimed as discussed above. However, Lorentzen/Panescu fails to disclose the stainless steel tubular electrode being malleable.

Art Unit: 3763

Ashley teaches a surgical instrument, (fig 4A-6A), where the tip and tubular shaft probe 404 (electrode) is made of the same tubing (such as a metal conducting shaft), and the shaft can be malleable stainless steel (col. 8 lines 40-59). Given the teachings, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use Ashley's malleable stainless steel material into Lorentzen/Panescu's catheter. Doing so would have improved the catheter conformation, particular for the patient's body, to access the location to be treated.

Response to Arguments

6. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nardella, and Nichols et al.

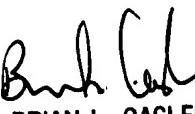
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cris L. Rodriguez whose telephone number is (703) 308-2194. The examiner can normally be reached on 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on (703) 308-3552. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

September 18, 2002


Cris L. Rodriguez
Examiner
Art Unit 3763


BRIAN L. CASLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700